UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,020	08/02/2001	Alicia Anne Chastain	RSW920010065US1	7793

7590	12/07/2004	EXAMINER

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EXAMINER
HAILU, TADESSE

ART UNIT	PAPER NUMBER
2173	

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>24 September 2004</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-7,9-16 and 18-21</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-7, 9-16, and 18-21</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>02 August 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____ .

DETAILED ACTION

1.   This Office Action is in response to the AMENDMENT submitted and entered on

September 24, 2004 for the patent application number 09/921,020, filed on August 2,

2001.

Status of the claims

2.   The pending claims 1-7, 9-16 and 18-21 are examined herein as follows.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3.   Claims 1-7, 9-16 and 18-21 are rejected under 35 U.S.C. 112, first paragraph, as

failing to comply with the written description requirement. The claim(s) contains subject

matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application

was filed, had possession of the claimed invention.

The relevant portion of the disclosure (page 13, line 20 through page 14, line 8)

reads, " The **tagging** of the highlighted passage for searching my be initiated using a

number of different mechanisms." The relevant portion of the disclosure also reads

"This note also may be **tagged** for research in these examples."

Although "tagging" is disclosed, it is not described as claimed in the invention.

Specially, independent claims 1, 18, 20 and 21 recite in part <u>wherein the user tags a</u>

beginning point and an ending point of any portion of text in the electronic book.

Independent claims 11 and 19 recite in part designating the text to use in a search

based on a user selected beginning point and a user selected ending point of any

portion of text located in an electronic document. Thus, The underlined portion does not

have support in the disclosure.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the
United States before the invention thereof by the applicant for patent, or on an international application
by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this
title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act

of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000.

Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior

to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.   Claims 1-7, 9-16 and 18-21 are rejected under 35 U.S.C. 102(e) as being

anticipated by Graham et al (US Pat No 6,457,026).

With regard to claims 1, 18 and 21:

Graham et al ("Graham") discloses a computer-implemented method for

researching highlighted or annotated text in an electronically stored document (or

electronic book), which contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and 9B).

The method at least in part includes receiving a user input via an input device (Fig. 1, #36). A relevant text is preceded by a tag (tag 1002) and followed by another tag (tag 1004) (i.e., beginning and ending tags) (column 8, lines 13-51). The use of these tags facilitates the annotation mode where complete sentences are highlighted and a user identifies the selected text after the e-book is displayed (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226, column 3, lines 56-66, column 4, lines 3-28, column 5, lines 32-50, column 8, lines 13-31).

The method also includes *automatic* web *search* process (automatically initiating a search), wherein when this web *search* process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web *search* tool such as Alta Vista™ is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57).

With regard to claim 2:

Graham further discloses a search for at least one item relevant to the selected text includes at least a World Wide Web document or another electronic document (column 7, lines 46-57).

With regard to claim 3:

Graham further discloses maintaining (storing) the selected text in a user profile file 516 data structure (Figs. 5, and 6A-6C, column 5, lines 13-16).

With regard to claims 4 and 12:

Graham discloses a method and system to facilitate reading a document.

Graham further discloses a document display system that is easily personalizable and

flexible as well (column 1, lines 47-50). Graham further discloses a pattern identification

stage that looks for particular patterns (or structure) in the parsed text output of text

processing stage. The particular patterns searched for are determined by the contents

of user profile file 516 (Fig. 6B, column 5, lines 32-50).

With regard to claim 5:

Graham also discloses that the selected text or key phrase is a highlighted text,

wherein the user may select any highlighted key phrase with the mouse (Fig. 2B, #220,

column 3, lines 57-63).

With regard to claim 6:

As illustrated in Fig. 2, Graham further discloses that the highlighted text is text in

a different color from unselected text, bolded text, and text with a different font type from

unselected text (column 3, lines 57-63, Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226).

With regard to claim 7:

Graham further discloses that the selected text is an entire sentence (or notated

passage of text) (Fig. 2C, #224) in the electronic document (or electronic book) and

wherein the notated passage of text is a user created note associated with at least a

portion of the electronic document (column 3, lines 57-column 4, lines 17).

With regard to claim 8:

Furthermore, as described above, Graham further discloses that the highlighted

text is a highlighted passage of text in the electronic document (or electronic book)

(column 4, lines 3-9, Fig. 2C, #224).

With regard to claim 9:

Graham further discloses document browser 506, receiving and viewing (or

presenting) the search result to a user (Fig. 5, column 4, lines 45-column 5, lines 17).

With regard to claim 10:

Graham further discloses receiving a result is initiated using a search engine,

such as, for example, a web *search* tool such as *Alta* Vista ™ is employed to look on

the World Wide Web for documents containing the keyword or key phrase (column 7,

lines 46-57).

With regard to claims 11 and 19:

Graham discloses a computer-implemented method for researching highlighted

or annotated text in an electronically stored document (or electronic book), which

contains plurality of pages including table of contents (see Figs. 2A-2D, 3, 4, 9A and

9B).

The method includes among other things, designating, or tagging the text to use

in a search in a search based on a user selected beginning and ending tags of any

portion of text located in an electronic document (column 8, lines 13-31); the method

also includes responsive to designating the text in the electronic document to use in

search, placing the text in a data structure, wherein the data structure is a search profile

(column 5, lines 9-16, column 6, lines 31-45);

Preparing and transmitting (via document browser 506) the selected highlighted

text to be searched by a web search tool such as Alta Vista ™ (column 7, lines 46-57).

The method further includes receiving (via document browser 506) the search

result from the web search (column 7, lines 46-57).

With regard to claim 12:

Graham also includes said text includes a user created note associated with the

text (column 3, lines 49-56, column 5, lines 3-8).

With regard to claim 13:

Graham further discloses that the search profile includes search criteria, such as,

or example searching by concept, title, name or keyword (see Fig. 8, column 6, lines

62-column) 7, lines 12).

With regard to claim 14:

As illustrated in Figs. 2A-2D, 3, 4, 9A and 9B, Graham further discloses the

electronic document is at least one of an electronic book and a web page.

With regard to claim 15:

Graham further discloses downloading the result from the search engine, that is,

the method enables the document browser 506 to retrieve (download) the results of

researched selected text (column 7, lines 46-57).

Graham also discloses displaying the result from the search engine, that is, the

method also enables the document browser 506 to display the results of researched

selected text (Figs. 5, and 6A through 6C, column 5, lines 1-16; column 5, lines 17-65).

<u>With regard to claim 16:</u>

Graham also discloses that designation or marking of the text is made by highlighting the text in the electronic document (Fig. 2B, #220, column 3, lines 57-63).

<u>With regard to claim 20:</u>

Graham discloses a data processing system (Fig. 1, #10) comprising: a bus system (12); a communication unit (40) connected to the bus system; a memory (16) connected to the bus system, wherein the memory includes a set of instructions.

Graham further discloses a processing unit (14) connected to the bus system, wherein the processing unit executes the set of instruction to receiving a user input (30 and 36) selecting the text from the electronic book to form selected text (see Fig. 2B, #220, Fig. 2C, #224, or Fig. 2D, #226). A relevant text is preceded by a tag (tag 1002) and followed by another tag (tag 1004) (i.e., beginning and ending tags) (column 8, lines 13-51).

Graham also discloses automatic web search process (automatically initiating a search) (column 7, lines 46-57), wherein when this web search process is enabled (via user input), whenever a particular keyword or key phrase is found frequently near where a defined concept is determined to be discussed, a web search tool such as Alta Vista ᵀᴹ is employed to look on the World Wide Web for documents containing the keyword (the selected text) or key phrase (column 7, lines 46-57).

Response to Arguments

5.   Applicant's arguments filed September 24, 2004 have been fully considered but they are not persuasive. The Applicant argues that Graham does not teach or suggest

every element of the claimed invention. The Applicant further specifies, Graham does

not teach or suggest the "receiving" step as recited in independent claims 1, 18, 20, and

21. The Applicant further strongly argues that Graham provides no ability for a user to

select a portion of a displayed electronic book, by tagging a beginning point and an end

point..."

The Examiner strongly disagrees because it is Graham who teaches tagging

beginning point and an end point, or special tags around particular words or phrases

(column 8, lines 13-31) not the present invention. The present invention merely

describes tagging. The relevant portion of the disclosure (page 13, line 20 through page

14, line 8) reads, " The tagging of the highlighted passage for searching my be initiated

using a number of different mechanisms." The relevant portion of the disclosure also

reads "This note also may be tagged for research in these examples."

The Applicant also argues that Graham does not teach or suggest that a user

can select any portion of text from an electronic document after the electronic document

is displayed and automatically searching for items relevant to the selected text in

response to the user input selecting the text. The Examiner disagrees because as given

rejection above and as described in column 7, lines 26-column 8, lines 12, Graham

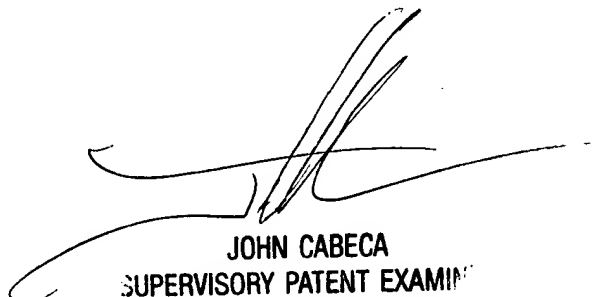describes the limitation.

Conclusion

6.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the

Examiner should be directed to Tadesse Hailu, whose telephone number is (571) 273-

4051. The Examiner can normally be reached on M-F from 10:00 - 630 ET. If attempts

to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, John

Cabeca, can be reached at (571) 273-4048 Art Unit 2173. .

8.   Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the Group receptionist whose telephone number is

(703) 305-3900.

Tadesse Hailu
Novembre 24, 2004

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